

REMARKS

This responds to the Office Action mailed on November 30, 2004.

Independent claims 5, 13, 20, and 27 are amended. No claims are canceled or added. As a result, claims 5-30 are now pending in this application.

Rejection of Claims 5-8, 10, 11, 13-15, 17, 20-22, 24, and 27-29 under 35 U.S.C. §103(a) as Unpatentable over Funaki in view of Berke

Claims 5-8, 10, 11, 13-15, 17, 20-22, 24, and 27-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki (U.S. 6,689,946) in view of Berke (U.S. 6,629,094).

Funaki discloses a computer-based song-writing system for retrieving candidate words to match corresponding music (see col. 12, lines 7-28). The candidate words may be selected in part based upon the number of syllables they contain, and in part based upon the words' part of speech. It is noted that in Funaki the search engine does not retrieve from the database a unique hit, but rather the search engine may retrieve several candidate words (see col. 8, lines 44-45). Further, it will be noted that in Funaki the search engine retrieves individual words rather than a document.

Berke discloses a search engine that provides a unique hit (e.g., in the form of a web site) for each combination of a trademark and an associated product or service. (See Abstract.) However, Berke does not mention anything about "syllables".

Regarding Applicant's independent claims 5, 13, 20, and 27, the Examiner agrees that Funaki does not explicitly teach the limitation "using the ordered sequence of syllable counts to retrieve from a database a document uniquely represented by the search string".

However, the Examiner asserts that it would have been obvious to a person of ordinary skill in the art to apply Berke's teaching of uniquely identifying a single web site corresponding to search criteria, by examining Funaki's database for a unique combination stored in the database in order to save time for users reading or searching documents and to eliminate displaying irrelevant documents to a user.

Applicant respectfully traverses the Examiner's argument. First, motivation is lacking in the Funaki system to retrieve a unique word. The objective of the Funaki system is not necessarily to improve time efficiency, but rather it is producing an artistic work having an aesthetic effect. This inherently requires the retrieval of candidate words and the user's careful and artistic evaluation and selection of the optimum word (see col. 2, lines 29-30; col. 12, lines 21-25).

Second, Funaki doesn't retrieve documents for a user, as stated by the Examiner. Rather, Funaki retrieves individual words. Each of Applicant's independent claims 5, 13, 20, and 27 has been amended to recite that the database contains analyzed documents, and that each document comprises a plurality of words. It will be noted that in Funaki, the database comprises a plurality of words, not a plurality of documents. When a match occurs in Funaki, a word having the indicated number of syllables and the desired part of speech is returned. If more than one word is found, multiple words may be returned. However, in Funaki the database only contains individual words, not documents each comprising a plurality of words. Thus, Funaki's system is patentably distinguishable from that of Applicant's independent claims 5, 13, 20, and 27.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

The asserted combination of Funaki in view of Berke fails to teach or suggest all of the claim limitations present in independent claims 5, 13, 20, and 27, so a *prima facie* case of obviousness has not been established.

For the above reasons, claims 5, 13, 20, and 27 should be found to be allowable over any combination of Funaki and Berke, and Applicant respectfully requests that the rejection of claims 5, 13, 20, and 27 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke should be withdrawn.

Claims 6-8, 10-11, 14-15, 17, 21-22, 24 and 28-29, which depend from claims 5, 13, 20, and 27, respectively, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above. Applicant respectfully requests that the rejection of claims 6-8, 10-11, 14-15, 17, 21-22, 24, and 28-29 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke should be withdrawn.

Rejection of Claims 9, 16, and 23
under 35 U.S.C. §103(a) as Unpatentable
over Funaki in view of Berke and Further in view of Erickson

Claims 9, 16, and 23 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Erickson (U.S. 5,765,152).

Erickson discloses a system to provide access to copyrighted media. However, there is no mention of “syllable” in Erickson. The Examiner asserted that claims 9, 16, and 23 don’t mention the word “syllable”; however, these claims incorporate all of the limitations of the independent claims upon which they depend, and the independent claims recite the word “syllable”.

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. MPEP §2143.03.

Independent claims 5, 13, and 20 are asserted to be patentable over Funaki in view of Berke for the reasons presented by Applicant above.

Thus, claims 9, 16 and 23, which indirectly depend from claims 5, 13, and 20, respectively, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above, and Applicant respectfully requests that the rejection of claims 9, 16 and 23 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Erickson should be withdrawn.

Rejection of Claims 12, 18, 19, 25, 26, and 30
under 35 U.S.C. §103(a) as Unpatentable
over Funaki in view of Berke and Further in view of Wu

Claims 12, 18, 19, 25, 26, and 30 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Wu (U.S. 5,991,756).

Wu discloses a search engine to retrieve documents matching a query term that may comprise a plurality of sub-terms. However, there is no mention of “syllable” in Wu. As mentioned above, the Examiner asserted that claims 9, 16, and 23 don’t mention the word “syllable”; however, these claims incorporate all of the limitations of the independent claims upon which they depend, and the independent claims recite the word “syllable”.

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. MPEP §2143.03.

Independent claims 5, 13, 20, and 27 are asserted to be patentable over Funaki in view of Berke for the reasons presented by Applicant above.

Thus, claims 12, 18, 19, 25, 26 and 30, which depend, directly or indirectly, from claims 5, 13, 20, and 27, respectively, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above, and Applicant respectfully requests that the rejection of claims 12, 18, 19, 25, 26 and 30 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Wu should be withdrawn.

Additional Elements and Limitations

Applicant considers additional elements and limitations of claims 5-30 to further distinguish over the cited references, and Applicant reserves the right to present arguments to this effect at a later date.

Conclusion

Applicant respectfully submits that claims 5-30 are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602) 298-8920, or the below-signed attorney (located in Minneapolis, Minnesota) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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Date Jan. 31, 2005

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 31st day of January, 2005.

Dennis J. Kamph

Name

[Signature]
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